

**REMARKS****I. Summary of the Office Action**

Claims 1-13 are pending in the application. The Examiner has rejected claims 1-13 under 35 U.S.C. §103(a), asserting that such claims are obvious in view of U.S. Patent No. 5,283,731 to Lalonde et al. ("Lalonde").

**II. Summary of this Reply**

In this Reply, claims 1, 2 and 6-13 are amended. Previously withdrawn claims 14-20 are canceled herein. New claims 21-32 are added; no new matter is added. Support for the new claims can be found, *inter alia*, in the claims as originally filed and in the detailed description at page 6, lines 4-21; page 8, lines 3-21; page 9, lines 3-12; and page 10, lines 5-15.

**III. Discussion of the Cited Art**

Lalonde discloses a computer-based classified ad system and method by which an ad database is created and/or used. The system includes a data processor for receiving profile data describing an item. The system may include an interactive voice response (IVR) system. The IVR system converts text output data into a voice message so that buyers can listen to ads via a telephone.

When the system receives an incoming call and recognizes it as a voice call, the IVR system plays a pre-stored new caller voice script including any introductory information, instructions on how to use the system, etc. The script may ask the caller to identify a desired function, for example by pressing designated touchtone keys on the caller's telephone. The system analyzes the function that the caller has requested and routes control accordingly. See Figure 2, blocks 112, 114, 116; col.

5, lines 29-51. If the caller is a seller, then the caller can ask to place a new ad in the system. Col. 5, lines 53-55.

**IV. Response to 103 Rejections**

The Examiner has rejected claims 1-13 under 35 U.S.C. §103(a), asserting such claims are obvious in view of Lalonde.

A Section 103 rejection is proper only if all claim limitations are taught or suggested by the prior art. MPEP § 2143.03. Even if all elements are found in the cited art, there must also be motivation in the art to make the proposed combination. MPEP § 2143.01.

**Claims 1 and 2**

Independent claim 1 is directed to a "computer-implemented method for listing an independent seller's good for sale using a CPU, a memory operatively connected to the CPU and a program stored in the memory and executable by the CPU for presenting the good for sale on a website." The claimed method includes "receiving from a seller information identifying a good, the information comprising a series of tones generated by depression of keys of a telephone." Contrary to the Examiner's assertion on page 3 of the Action, Lalonde fails to teach or suggest "receiving from a seller information identifying a good, the information comprising a series of tones generated by depression of keys of a telephone." In Lalonde, while the system may receive information comprising a series of tones generated by depression of keys of a telephone, such information is not information identifying a good.

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As discussed above, Lalonde's system includes an IVR system with which a caller may interact, e.g. by pressing designated touchtone keys on the caller's telephone.

However, if the caller is a seller asking to place a new ad in the system, the system routes control away from the IVR system. Col. 5, lines 53-55; Figure 2, blocks 112, 114, 116; col. 5, lines 29-51. With respect to routing of a seller's call, Lalonde states that:

[i]f the incoming caller identifies itself as a seller wishing to place a new ad, then the IVR identifies the caller's requirement as pertaining to a non-IVR based function, and sends an operator request message to [database server] 16 via serial line 24, as shown in block 116 of FIG. 2. In response to the operator request message, the [database server] begins prompting the operator at [computer] terminal 40 for information relating to the ad. In turn, the operator relays these requests to the seller via [headphone/microphone] headset 42 and [telephone] switch 12, receives the seller's responses by the same path, and inputs such responses to [database server] 16, to create a new ad in database 30. Col. 6, lines 3-18.

It is further noted that Lalonde states at col. 6, lines 14-18 that "this step could be automated using the IVR." However, "this step" relates to the step discussed in the same paragraph (col. 6, lines 3-18), namely, the method step shown at block 116 in the method flowchart of Figure 2, which reads "send [operator] request message to DBS." Lalonde further states that although this particular step could be automated using the IVR, that it is preferable to "use a human operator as an interface [for receiving ad information], because of the amount of variability involved in placing an ad, explaining to the seller the options available, etc." Col. 6, lines 14-18. Thus Lalonde teaches away from use of an IVR to gather ad listing information.

Thus, Lalonde teaches that the IVR is not used to interact with a seller to receive information about a good. Instead, Lalonde teaches that the call is routed to a human operator who interacts with the seller by telephone. For at least this reason, Lalonde fails to teach or suggest all limitations of claim 1.

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Claim 1 further recites "presenting the good for sale on a website." The Examiner acknowledges on page 3 of the Action, that Lalonde does not disclose presentation of a good for sale on a website. Instead, the Examiner asserts that:

presentation of the good for sale in the pre-Internet method of Lalonde et al. is not on a website. However, using a website to present a good for sale is a well-known, hence obvious, step to follow for those of ordinary skill in the art. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Lalonde et al. so as to use a website for presenting the good for sale . . . .

Applicants traverse the Examiner's assertion that the time of the Lalonde's invention, for which the Lalonde patent's application was filed on December 23, 1992, was "pre-Internet." It is widely recognized that the "Internet" has a history dating back to approximately 1969. The Examiner is invited to substantiate the Examiner's assertion to the contrary, the *prima facie* burden of establishing obviousness being on the Examiner. For at least this reason, Lalonde fails to teach or suggest all limitations of claim 1.

Claim 2 depends from claim 1 and is likewise patentable.

For at least these reasons, reconsideration and withdrawal of the rejections of claims 1 and 2 are requested respectfully.

### **Claims 3-8**

Claims 3-8 depend from claim 1 and are likewise patentable. Claim 3 further recites that "the series of tones comprises tones generated by depressing the telephone's keys in a sequence corresponding to an alphanumeric sequence of a standard identification code." Claim 4 recites that "the standard identification code is a universal product code." Claim 5 recites that "the standard identification code is an international standard book number."

The Examiner states on pages 3-4 of the Action that:

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The Examiner states on pages 3-4 of the Action that:

Lalonde . . . does not include that the tones generated indicate a sequence corresponding to an alphanumeric sequence of a universal product code (UPC), international standard book number (ISBN), or other standard identification code.

Applicants agree. Further, Applicants acknowledge that standard product identification codes such as UPC and ISBN number are well-known to those of ordinary skill in the art.

However, Applicants traverse the Examiner's assertion that it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Lalonde so as to allow a standard identification code such as UPC or ISBN to be entered in order to conveniently identify the good being sold. There is absolutely no teaching or suggestion whatsoever of any use of UPC, ISBN or other standard identification codes in Lalonde.

Further, there is no motivation to make the proposed combination. The Examiner has not cited any motivation in Lalonde for modifying the reference to arrive at the claimed invention. The U.S. Court of Appeals for the Federal Circuit has considered the issue of finding motivation in this context and stated that a finding of motivation "must be based on objective evidence of record" and that:

[an] Examiner's conclusory statements . . . do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority." *In re Sang-Su Lee*, 277 F.3d 1338, 1343-44 (Fed. Cir. 2002).

The Examiner asserted on page 4 of the Action that it would be obvious to modify Lalonde to allow a standard identification code to be entered "since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results." The Examiner's

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basis for this statement has not been identified. It appears to be the Examiner's own subjective conclusion.

The Federal Circuit has clarified that conclusory statements asserting motivation that are based on "common knowledge and common sense" are not sufficient to fulfill the Board of Patent Appeals' obligation to develop an evidentiary basis for its findings. *Id.* There is no objective evidence of record, particularly in Lalonde, providing the asserted motivation.

Further, there cannot be motivation to make the proposed modification of Lalonde because doing so would destroy the purpose of the system/method of Lalonde and/or render it unsatisfactory for its intended purpose, because the system/method provides for a human operator's receipt of information from a seller, and limitation of system functions to certain other functions. Use of touch tones, which would be unrecognizable to the human operator, to provide good related information would render the human operator unsatisfactory for its intended purpose of gathering information from a seller, or would change the principle of operation of selectively routing calls to a human operator.

For at least these reasons, reconsideration and withdrawal of the rejections of claims 3-8 are requested respectfully.

**Claims 9, 10, 21 and 22**

Claims 9 and 10 depend from claim 6 and are likewise patentable. In addition, amended claims 9 and 10 recite "determining a recommended sale price for the good, the sale price being information relating to the good that is retrieved from the database." The Examiner states on pages 4 and 5 of the Action that

Applicants traverse the Examiner's assertion that the proposed modification would have been obvious. Further, the claim has been amended to recite that the sale price information relating to the good is retrieved from the database. This is neither taught nor suggested by Lalonde. Further, it is noted that this retrieval of sale price information from a database is part of the process of a seller's listing of a good for sale, not part of the buyer's browsing process. Lalonde provides absolutely no teaching or suggesting of retrieving information relating to a good, such as sale price information, from a database as part of the process of listing an item for sale. Lalonde discloses only receiving information from a seller. Lalonde's disclosure of retrieving information from a database relates only to the buyer's buying process, i.e., presenting previously stored ad information to a potential buyer.

For at least these reasons, reconsideration and withdrawal of the rejections of claims 9 and 10 are requested respectfully.

New claims 21 and 22 are similar to claims 9 and 10, respectively. However, claims 21 and 22 depend from claim 3 and relate to use of the standard identification code to retrieve a price recommendation from the database. See application, page 8, lines 10-21. This is neither taught nor suggested by Lalonde. Claims 21 and 22 are thus believed patentable.

### **Claims 11 and 12**

Claims 11 and 12 depend from claim 1 and are likewise patentable. In addition, claim 11 recites "receiving a seller identification code that identifies the seller." Claim 12 recites that "the seller identification code received comprises tones generated by depressing the telephone's keys in a sequence corresponding to an alphanumeric sequence identifying the seller."

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Contrary to the Examiner's assertions on page 5 of the Action, Lalonde provides absolutely no teaching or suggestion of any recognizable seller identification code associated with a seller. At most, Lalonde discloses a transaction identifier (TransId) that is assigned to a particular call, and is not associated with any particular seller. In fact, the transaction identifier is assigned before it is determined who the caller is, and whether the caller is a buyer or seller. Col. 5, lines 29-37. The same seller could make multiple calls, each with a different transaction identifier.

Further, it is noted that the rejection is conclusory, and merely a restatement of the rejected claims, with absolutely no reference to any portion of Lalonde, or any language from Lalonde. The Examiner is reminded of 37 CFR §1.104(c)(2) regarding the Examiner's identification of the particular part of a reference that is relied upon, and is invited to identify with specificity any portion of Lalonde believed to disclose "receiving a seller identification code identifying the seller." Clarification is earnestly solicited.

### **Claim 13**

Claim 13 depends from claim 11 is likewise patentable. In addition, claim 13 recites "wherein the seller identification code is a telephone number of the telephone from which the seller is calling." The Examiner states on page 5 of the Action that "Lalonde et al. does not explicitly include that the seller identification code is a telephone number of the telephone from which the seller is calling." Applicants agree. Applicants traverse the Examiner's rejection that the claimed subject matter is taught or suggested by Lalonde. The Examiner is requested to carefully review and reconsider claim 13 and the outstanding rejection.

Claim 13 further recites that "receiving a seller identification code identifying the seller comprises recognizing the telephone's telephone number by a caller identification technique." This is neither taught nor suggested by Lalonde.

For at least these reasons, reconsideration and withdrawal of the rejection of claim 13 are requested respectfully.

**New claims 23-31**

New independent claim 23 is directed to a computer-implemented method including "receiving from a seller a series of tones comprising tones generated by depressing keys of a telephone in a sequence corresponding to an alphanumeric sequence of a standard identification code; adding the good to a virtual inventory of goods being offered for sale; retrieving from the memory information associated with the standard identification code, the information relating to the good; and presenting the good for sale on a website to display the information retrieved from the memory using the standard identification code." New claim 27 recites that "adding the good to a virtual inventory of goods being offered for sale comprises storing in the memory the standard identification code." As discussed above, Lalonde neither teaches nor suggests any use of a standard identification code, or any display on a website. Further, Lalonde neither teaches nor suggests using the standard identification code to add a good to a virtual inventory of goods, and there is no motivation to modify Lalonde in this manner.

Claim 24 involves receiving a series of tones identifying a characteristic of the good that is incapable of being discerned from the standard identification code. This is neither taught nor suggested by Lalonde.

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Claim 25 recites that "retrieving from the memory information associated with the standard identification code, and the presenting the good for sale on a website are performed after a buyer inquires about the good." Claim 26 recites that the "retrieving from the memory information associated with the standard identification code, and the presenting the good for sale on a website are performed after a buyer's search for the good." Accordingly, a complete sale listing is compiled and displayed only after a buyer's inquiry or search. In contrast, Lalonde discloses gathering all sale information (1) from the seller and (2) during the initial process of creating an ad/listing a good for sale, before a buyer's inquiry/search.

New claim 28 recites that "retrieving from the memory information associated with the standard identification code comprises retrieving a recommended sale price for the good, the method further comprising providing the recommended sale price to the seller." As discussed above, Lalonde neither teaches nor suggests any retrieval of suggested price information from a database, or using a standard identification code as a reference.

Claims 29-31 relate to receipt of a seller identification code that is recognizable to identify seller information previously provided in association with the seller. This is neither taught nor suggested by Lalonde. Claim 31 further recites that the seller identification code is a telephone number of the telephone from which the seller is calling, and is recognized as the seller's telephone number by a caller identification technique. This is neither taught nor suggested by Lalonde.

Claim 32 recites that "presenting the good for sale" includes "displaying via the website information provided by the seller" as well as "displaying via the website additional information not provided by the seller, the additional information being retrieved from a database, the additional information being stored in the database in

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association with the standard identification code provided by the seller." Thus, the standard identification code provided by the seller is used to identify certain information about the seller's good, and that certain information is displayed on the website when presenting the good for sale in addition to any information provided by the buyer. The standard identification code provided by the seller provides a reference for retrieving information pertinent to the seller's good. This is neither taught nor suggested by Lalonde.

For at least these reasons, new claims 21-32 are patentable.

**CONCLUSION**

In view of the foregoing amendments and remarks, Applicants believe claims 1-13 and 21-32 to be patentable and the application in condition for allowance, and request respectfully issuance of a Notice of Allowance. If any issues remain, the undersigned requests a telephone interview prior to the issuance of an action.

Respectfully submitted,

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